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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,535	06/09/2006	Stephanic Magnet	FR-AM-1994 NP	9897
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EXAMINER				
PENG, KUO LIANG				
ART UNIT		PAPER NUMBER		
1796				
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12/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/582,535

Applicant(s)

MAGNET ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/2/08 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date 6/9/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traverse of the invention of Group I (Claims 1-11 and 17-20) in the response to restriction requirement filed September 2, 2008 is acknowledged. Applicants further elected Species A: where the polyfunctional radical is organic. Claim 1 is amended. Claims 3 are withdrawn. Claims 12-16 and 21 are deleted. Now, Claims 1-2, 4-11 and 17-20 are pending for consideration.

Claim Objections

2. Claims 1-2, 4-11 and 17-20 are objected to because of the following informalities:

In Claim 1, there are two "n" (one in line 2 and the other in the core formulae) that might cause confusion.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-11 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 1 recites the broad recitation "acids and their derivatives" (lines 13-14), and the claim also recites "such as acrylic acid, methacrylic acid and their sodium or potassium salts" (lines 14-15) which is the narrower statement of the range/limitation. The "such as" in Claim 18 has the similar issue. Claim 9 recites

the broad recitation "Tg of less than 0°C" (lines 2), and the claim also recites "preferably of less than -30°C" (line 2) which is the narrower statement of the range/limitation. The "preferably" in Claims 10 and 11 has the similar issue.

In Claim 1, "n" in the formulae is not defined.

In Claims 5 (line 1) and 7 (line 1), "preferably" causes confusion because it is not clear as to what is the less preferred embodiment.

In Claim 18 (line 2), it is not clear as to what "trimellitate **type**" refers to.
(Emphasis added)

Claim 18 contains the trademark/trade name "Catenex N 956". (line 3)
Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a plasticizer and, accordingly, the identification/description is indefinite.

In Claim 19 (last line), "typically" causes confusion because it is not clear as to what a non-typical embodiment is.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-8, 10 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesvadba (US 6 262 206).

For Claims 1, 4-8 and 17-20, Nesvadba discloses an adhesive comprising a **block copolymer** derived from a) at least one ethylenically unsaturated monomer such as (alkyl)acrylate, (alkyl)acrylic acid, styrene, etc.; and b) an initiator of **formula (I)**. The block copolymer can have a first block derived from **(alkyl)acrylate** and a second block derived from **(alkyl)methacrylate**. (col. 2, line 64 to col. 4, line 58, col. 6, lines 50-58, col. 9, lines 34-61, col. 11, lines 7-63, col. 12, lines 22-33 and Examples B16, B30, etc.) For Claim 10, the amount of the monomer for the first block and that for the second block are typically very similar

as shown in Examples. The molecular weight of the block copolymer as a whole is described in col. 12, lines 39-51. Therefore, the molecular weight of the first block should fall within the claimed range. Furthermore, the polydispersity of the copolymer is described in col. 12, lines 52-55. As such, the polydispersity of the first block should also fall within the claimed range. Alternatively, since the polymerization mechanism is similar to that of the present invention, the polydispersity of polymer (including the first block) should be very similar to the claimed one.

7. Claims 1-2, 4-8, 10 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Guerret (US 6 657 043).

Guerret discloses a block copolymer derived from an initiator of formula (I). (col. 1, line 43 to col. 4, line 46 and Examples) The first block of the copolymer can be derived from (alkyl)acrylate, and the second block can be derived from styrene. The molecular weight of the first block and the polydispersities of the blocks are also disclosed. (Example 1D)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nesvadba.

Nesvadba discloses an adhesive comprising a block copolymer, *supra*, which is incorporated herein by reference. Nesvadba's block copolymer contains a first block of poly(alkyl)acrylate and a second block of poly(alkyl)methacrylate. (Examples) As the reference discloses all the limitations of a claim except a property (Tg), and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

10. Claims 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guerret.

Guerret discloses a block copolymer, *supra*, which is incorporated herein by reference. As the reference discloses all the limitations of a claim except a property (Tg), and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

11. The “X” reference, (WO 03/046032, US 2003/0124074) cited in the international search report are not relied upon because of the following reason:

The instant reference does not teach or fairly suggest the claimed block copolymer where the first block and the second block are derived from the specifically claimed monomers.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
December 8, 2008

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796